

REMARKS

In view of the following remarks, Applicant respectfully requests reexamination of the present application.

The Examiner has rejected all pending claims under 35 U.S.C. § 102(e) and/or 35 U.S.C. § 103 citing U.S. Patent No. 6,547,617 to Kawamura et al (“the ‘617 patent”) and various other references. The ‘617 patent is a national stage application of Japanese PCT application PCT/JP99/03680 (“the PCT application”). The PCT application was filed prior to November 29, 2000 and published in the Japanese language on January 20, 2000 as PCT Publication No. WO00/03408. The front page of the ‘617 patent notes that the § 371(c)(1), (2), (4) date is January 5, 2001.

The present application was filed on January 31, 2000 and claims priority to U.S. Provisional Patent Application No. 60/ 118,038 filed February 1, 1999 (“the ‘038 provisional application”).¹ As explained in further detail below, because: (a) the § 371 date of the ‘617 patent is after the filing date of the present application, (b) the PCT application publication date is after the priority date of the present application, (c) the claims of the present application are supported by the written description and claims of the ‘038 provisional application, and (d) the ‘038 provisional application and the present application have at least one inventor in common, neither the ‘617 patent nor the PCT application is a proper prior art reference under 35 U.S.C. § 102 and cannot be used to reject the presently pending claims.

35 U.S.C. § 102(e)

Applicant respectfully submits that neither the ‘617 patent nor the PCT application is a proper prior art reference under 35 U.S.C. § 102(e). As noted in § 706.02(a) of the MPEP, “no international filing dates prior to November 29, 2000 may be relied upon as a prior art date under 35 U.S.C. 102(e).” Since the PCT application was filed before November 29, 2000, the filing date of

¹ The present application also claims priority as a continuation-in-part of U.S. Patent Application No. 09/141,393 filed August 27, 1998, now U.S. Patent No. 6,197,218, U.S. Patent Application No. 09/141,405 filed August 27, 1998, now U.S. Patent No. 6,168,731, U.S. Patent Application No. 09/140,525 filed August 27, 1998, now U.S. Patent No. 6,193,908 and U.S. Patent Application No. 09/141,386 filed August 27, 1998, now U.S. Patent No. 6,210,604, each of which is a continuation-in-part of U.S. Patent Application No. 09/030,060 filed February 24, 1998, now U.S. Patent No. 6,153,123, U.S. Patent Application No. 09/028,603 filed February 24, 1998, now U.S. Patent No. 6,180,029 and U.S. Patent Application Serial No. 09/030,057 filed February 24, 1998, now U.S. Patent No. 6,338,809, each of which claim priority to U.S. Provisional Patent Application No. 60/038,262 filed February 24, 1997 and U.S. Provisional Patent Application No. 60/039,450 filed February 24, 1997.

the PCT application is not a proper § 102(e) date. Instead, the proper § 102(e) date is the date that the requirements of 35 U.S.C. § 371(c)(1), (2) and (4) were met. *See* MPEP §§ 706.02(a), (f)(1). As noted above, the PCT application fulfilled the requirements of 35 U.S.C. § 371(c)(1), (2) and (4) on January 5, 2001. The filing date of the present application was January 30, 2000, well before the PCT application fulfilled the requirements of 35 U.S.C. § 371(c)(1), (2) and (4). Therefore, neither the PCT application nor the ‘617 patent is a proper prior art reference under 35 U.S.C. § 102(e).

35 U.S.C. § 102(a)

Applicant also respectfully submits that neither the PCT application nor the ‘617 patent is a proper prior art reference under 35 U.S.C. § 102(a). To be a proper prior art reference under 35 U.S.C. § 102(a), the reference must, *inter alia*, have a publication date earlier in time than the effective filing date of the application. *See* MPEP § 706.02(a). The ‘617 patent published when it issued on April 15, 2003, well after the filing date of the present application, and therefore is not a proper § 102(a) prior art reference. As is discussed in further detail below, the PCT application is also not a proper § 102(a) reference as the priority date of the present application, February 1, 1999, is earlier than the publication date of the PCT application, January 20, 2000.

Applicant notes that for “a non-provisional utility application to be afforded the priority date of [a] provisional application, the [sic] applications must share at least one common inventor and the written description of the provisional application must adequately support the claims of the non-provisional application.” New Railhead Mfg. LLC v. Vermeer Mfg. Co., 298 F.3d 1290, 1294 (Fed. Cir. 2002). “In other words, the specification of the provisional must ‘contain a description of the invention and the manner and process of making and using it, in such full, clear, concise and exact terms’ to enable an ordinary skilled artisan to practice the claimed invention in the non-provisional application.” Id. *See also* MPEP § 201.11(I).

Applicant respectfully submits that the currently pending claims are adequately supported by the written description and claims of the ‘038 provisional application. Therefore, the claims of the present application should be afforded the priority date of the ‘038 provisional application. Id. For example, supporting disclosure for pending Claims 12-20 and 24-38 can be found, *inter alia*, in the claims of the ‘038 provisional application (e.g., Claims 1-24) and on pp. 5-14 and 47-53 of the ‘038 provisional application. For the Examiner’s convenience, attached in Appendix A is a copy of the ✓

‘038 provisional application. Additionally, the utility and provisional applications have at least one inventor in common (e.g., Kodas and Hampden-Smith). In view of the foregoing, Applicant respectfully submits that the claims of the present application have a priority date of February 1, 1999. Id. As this priority date is earlier than the publication date of the PCT application (i.e., earlier than January 20, 2000), the PCT application is not a proper prior art reference under 35 U.S.C. § 102(a).

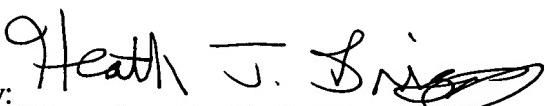
In view of the foregoing, Applicant respectfully submits that neither the ‘617 patent nor the PCT application is a proper prior art reference under 35 U.S.C. § 102, and therefore neither can be used to reject the claims under 35 U.S.C. §102 or under 35 U.S.C. § 103. *See* MPEP § 2141.01.

In view of the foregoing, Applicant respectfully submits that the pending claims are allowable and their allowance is respectfully requested. In the event that a telephone conversation would further expedite disposition of this application, the Examiner is invited to contact the undersigned.

It is not believed that any fees are owed with respect to this response. However, please debit any necessary fees from Deposit Account No. 50-1419.

Respectfully submitted,

MARSH FISCHMANN & BREYFOGLE LLP

By: 

Heath J. Briggs
Registration No. 54,919
3151 South Vaughn Way, Suite 411
Aurora, Colorado 80014
(303) 338-0997

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